

REMARKS

Claims 52-60 are pending in the present application. None of the claims were amended in this response.

Claim 55 was objected to for being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims.

Claims 52-58 were again rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants traverse this rejection. Specifically, the Office Action argues that claim 52 defines a “system”, while the body of the claim recited software modules and as such is non-statutory. Applicants submit that there is no support whatsoever for this contention, either in case law or in the MPEP. Software and algorithmic processes, including software systems, have long been held as statutory subject matter (see MPEP 2106), and nothing was identified in the present claims that even remotely suggests otherwise. Applicants respectfully request the rejection be withdrawn.

Claims 52-54, 56-60 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ramous* (U.S. Patent 5,896,533) in view of *Pratt* (U.S. Patent 5,564,044). Applicants respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

As was previously argued, regarding claim 52, *Ramous* does not teach “an object embedding program, implemented on a computer in said communications network, comprising a link to said network-based information provided by said one of said network servers and a link from which said object embedding program can locate said script program.” This feature is similarly claimed in claim 59 and 60. The Presentation Mechanism 304 of *Ramous* allows the OLE to link objects manufactured by OLE servers 302 (col. 4, lines 6-12). *Ramous* does not teach a link from which an object embedding program can locate said script program, because the Presentation Mechanism is always present between the container application and the OLE server (col. 4, lines 27-37). The Office Action dated June 27, 2005 has apparently conceded this point.

However, *Ramous* also does not teach the object embedding program “being structured to apply said script program to said network-based information so as to cause said data to be extracted from said network-based information” as recited in claim 52 (and similarly in claim 59 and 60). Applicants have previously provided support for this contention and continue to maintain it is this

response. The Presentation Mechanism 304 as disclosed in *Ramous* does not “extract data from network-based information provided by one of said network servers”, but instead replaces URLs with local files for the real OLE server to handle. In other words, the Presentation Mechanism does not “extract” anything, but instead passes embedded WWW documents with local copies made by the Data Access mechanism (see col. 5, lines 37-63). It is not understood how the “drag and drop” passage of col. 3, lines 50-55 relates at all to extracting data by a script program as recited in the present claims.

Next, the present invention claims an object embedding program, comprising “a link to said network-based information provided by said one of said network servers and a link from which said object embedding program can locate said script program.” The object embedding program is further structured to “apply said script program to said network-based information so as to cause said data to be extracted from said network-based information, and to embed said data within a compound document implemented on a computer in said communications network.” These features are recited in claim 52 and similarly in claim 59 and 60.

In contrast, the Office Action cites a general passage about OLE applications (col. 3, lines 49-55, 60-67) to allege that the aforementioned features are disclosed. The passage in col. 6, lines 10-15 merely describes a document insertion dialog, where the Presentation Mechanism 304 may be registered to appear in a menu list as a “WWW Document”. Again, how this passage relates to the features discussed above is still not clear.

Applicants respectfully repeat their objection to manner in which the present examination is being conducted. The above arguments are, once again, submitted in response to the previous rejection, pointing out clear and specific differences between the present claims and the cited *Ramous* reference. Furthermore, Applicants have conducted an interview on these points with the Examiner. Nevertheless, the Office Action, once again, fails to provide any further details or rebuttal arguments, but rather contain the same general rejection that has apparently been cut-and-pasted (at least since May 4, 2004). Furthermore, the Examiner apparently has manifested the intention of maintaining the recently-introduced rejection based on 35 U.S.C. §101 almost two years after the first office action was mailed on the same claims, and in complete contrast to the *Lundgren* decision issued by the BPAI. Withdrawal of the rejection is respectfully requested.

The latest office action has now introduced the *Pratt* document as allegedly teaching the features of an object embedding program locating a script program and being structured to apply the

script program. *Pratt* discloses a configuration where a user creates and stores a script (30) identifying the source data and directing the operation of the application program (FAP 12A) to generate the result data (RD 26) from the source data and inserts, a reference to the script (30) in the second data object (SDO 22B), wherein the reference identifies the script, the application program and an operation of the application program to execute the script. The user may then invoke the reference to indicate that a current version of the result data derived by operation upon a current version of the source data is to be provided to the second data object, whereupon the system resolves the reference to identify the script, the application program and the operation of the application program to execute the script and invokes the application program through a menu to execute the script to generate the result data from the source data and to provide the result data to the second data object (col. 3, lines 27-42; col. 5, line 63-col. 6, line 30; col. 8, lines 2-17). In other words, the configuration in *Pratt* discloses scripting and transferring changes from one application program to another application program all within the same computer and without the use of computer networks or the Internet. *Pratt* is completely silent regarding network-based information as is required by the present claims.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Ramous* and *Pratt* references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

As was mentioned previously, *Ramous* does not teach a link from which an object embedding program can locate said script program using networked-based information, because the Presentation Mechanism is always present between the container application and the OLE server (col. 4, lines 27-37). Moreover, *Pratt* merely describes a script program to copy and paste data from one application program (FAP) to another application program (SAP) within a user’s computer, and has no teaching in the reference that takes into account network-based information. Furthermore, *Pratt* relies on internal insert menu resources and “pop-up” menus to perform direct object linking and embedding (col. 7, lines 28-37). This is in conflict with the operation of *Ramous*, which expressly relies on the Presentation Mechanism to act as an OLE surrogate server and container to make local copies of a WWW document to determine server applications with which URL’s may be replaced with local files (col. 4, lines 15-40). There is no teaching in *Pratt* that reconciles how using internal menu-picking would even be operational under the configuration of *Ramous*.

For at least these reasons, the Applicants submit that the §103 rejection is improper and should be withdrawn. Since claims 53-58 depend directly and indirectly from claim 52, it follows that these claims are allowable as well. Applicants earnestly request an early Notice of Allowance.

If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0115274-00005) on the account statement.

Respectfully submitted,
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